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10/618,092	07/11/2003	Jason Lieblich	RFS-001	3820
22832 7590 07/09/2008 Kirkpatrick & Lockhart Preston Gates Ellis LLP (FORMERLY KIRKPATRICK & LOCKHART NICHOLSON GRAHAM) STATE STREET FINANCIAL CENTER One Lincoln Street BOSTON, MA 02111-2950				
EXAMINER GREENE, JOSEPH L				
ART UNIT 2151		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,092

Applicant(s)

LIEBLICH ET AL.

Examiner

JOSEPH L. GREENE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-850)
Paper No(s)/Mail Date 04/19/2006, 10/01/2003
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 – 32 are currently pending in this application.
2. Claims 22 - 28 are currently canceled.

Claim Interpretation

3. In the interest of expedited prosecution, the Examiner would like to note that claim 29 comprises the use of functional language to describe claim. In particular, the use of the term "capable of" raise questions as to the limiting effect of the functional language that follows them. The Examiner recommends amending the claims to contain positive recitations of the actions performed by the claim elements, rather than merely stating that the elements are "capable of" performing some future act. In the event that a hardware element is intended to contain software, which when executed, causes the hardware element to perform a function, the language of the claim should clearly express that relationship. In the interest of expedited prosecution, the limitation has been rejected, but Applicant is encouraged to amend the system claim so that the claimed functions are positively recited, to ensure that those limitations may be given patentable weight.

4. 10. See MPEP § 2111. See also *In re American Academy of Science Tech Center*, 2004 WL 1067528 (Fed. Cir. May 13, 2004) ("While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other

claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow") Further, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

7. With respect to claim 29, it is directed towards a system containing "a plurality of computer agents." Computer agents, however, are software implementations of hardware functions (i.e. they carry out the processes of monitoring and manipulating signals from a software standpoint). Furthermore, the applicant describes an agent, in section 0010, as such: **"A first agent executes on the first computer and compares the two data elements in order to assess the occurrence of an exceptional event."** The applicant's specification also goes on to describe an agent in section 0046 as: **"In the preferred embodiment, software comprising the Agent 208 continuously monitors the resources and events of the workstation, and periodically records information about said resources and events to the Agent's Database."**

Thus, evidence is provided that would conclude that the system could be interpreted as strictly software and that the applicant intended the agent to comprise a software implementation and thus, the claim is directed to non-statutory subject matter. In addition, claims 30-32 are dependent upon claim 29 and are thus, also directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-10, 13-20, and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Willard et al. (Patent No. US 7,058,953 B2), hereinafter Willard.

10. With respect to claim 1, Willard disclosed a distributed system for monitoring the resources and events of each of a plurality of networked computers (column 1, lines 6-12, where diagnosing problems contains the functions of managing events. i.e. where problems are events), the system comprising: (a) a first database associated with a first computer, said first database recording both a first data element and a second data element, wherein each of the first and second data elements comprise information

about a current state of the first computer at a given time (column 6, lines 52-60, where the first element is the normal state of a machine and the second element is the change of state that caused an event); and (b) a first agent executing on said first computer comparing the first and second data elements in order to assess the occurrence of an exceptional event (column 6, lines 56-60, where an example of an agent comparing data can be found in column 7, lines 19-22, where evaluating request and identifying providers requires the comparison of multiple data elements).

11. As for claim 2, Willard disclosed all of the limitations described in claim 1, including wherein the first and second data elements comprise information about a resource of the system (column 7, lines 19-22, where the provider's information is a resource).

12. As for claim 3, Willard disclosed all of the limitations described in claim 1, including wherein the first and second data elements comprise information about an application's behavior (column 6, lines 60-63, where the operating system, of the computer, is the application and the certain faults being recorded in an event log is the behavior monitoring).

13. As for claim 4, Willard disclosed all of the limitations described in claim 1, including wherein the first and second data elements comprise information about a

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user's actions (column 7, lines 19-22, where requesting management information is a user's actions).

14. As for claim 5, Willard disclosed all of the limitations described in claim 4, including wherein the first and second data elements further comprise information about a system response to the user's actions (column 8, lines 6-10, where performance issues are a systems response to a user's action of setting a test condition).

15. As for claim 6, Willard disclosed all of the limitations described in claim 1, including wherein the first and second data elements comprise information about a network (column 7, lines 34-37).

16. As for claim 7, Willard disclosed all of the limitations described in claim 1, including wherein the second data element is compared with the first data element before the second data element is stored in the database (column 2, lines 3-7, where the evaluation being stored means that the comparison has already taken place).

17. As for claim 8, Willard disclosed all of the limitations described in claim 7, including wherein the second data element is compared with the first data element in real time (column 2, lines 3-7, where the evaluation being stored means that the comparison has already taken place. Also, see column 10, lines 32-35).

18. As for claim 9, Willard disclosed all of the limitations described in claim 1, including a second computer agent executing on a second computer (column 6, lines 42-45, 56-60, where a different agent is a second agent).

19. As for claim 10, Willard disclosed all of the limitations described in claim 9, including wherein the first agent notifies the second agent of the occurrence of the exceptional event (column 8, lines 29-34, where the different agent is the second agent and the manager listed in column 8, lines 14-16 is the first agent).

20. As for claim 13, Willard disclosed all of the limitations described in claim 10, including wherein the second agent generates and sends a response to the first agent (column 8, lines 29-34, where the different agent is the second agent and the manager listed in column 8, lines 14-16 is the first agent).

21. As for claim 14, Willard disclosed all of the limitations described in claim 13, including wherein the response comprises instructions to the first agent related to the exceptional event (column 8, lines 29-34, where the different agent is the second agent and the manager listed in column 8, lines 14-16 is the first agent and where the state of the different agent was triggered by an event).

22. As for claim 15, Willard disclosed all of the limitations described in claim 1, including wherein the first agent notifies a human user of the occurrence of the exceptional event (column 7, lines 34-37).

23. As for claim 16, Willard disclosed all of the limitations described in claim 1, including wherein the first agent notifies a server executing on a second computer of the occurrence of the exceptional event (column 7, lines 19-22, where the providers are independent entities containing their own servers/databases and obtaining the information requires that the appropriate servers be notified).

24. As for claim 17, Willard disclosed all of the limitations described in claim 16, including a second database located on the second computer storing the notification received from the first agent (column 7, lines 19-22, where the providers are independent entities containing their own servers/databases and obtaining the information requires that the appropriate servers be notified).

25. As for claim 18, Willard disclosed all of the limitations described in claim 17, including the server transmitting a response to the agent (column 7, lines 19-22, where the response is commencing the transmission of data).

26. As for claim 19, Willard disclosed all of the limitations described in claim 17, including the server storing the response in the second database (column 7, lines

19-22, where the providers are independent entities containing their own servers/databases and obtaining the information requires that the appropriate servers be notified. Also where the server is keeping track of who is pulling information. Thus, it's storing the response that allowed the download to commence).

27. As for claim 20, Willard disclosed all of the limitations described in claim 1, including wherein the database comprises a relational database (column 10, lines 11-14).

28. With respect to claim 29, Willard disclosed a peer-to-peer system for monitoring the status of computers in a computer network (column 1, lines 6-12 and column 5, lines 28-30), the system comprising: a plurality of computer agents, each agent capable of repeatedly storing status information in a database at discrete points in time (column 6, lines 52-66), each agent further capable of receiving, storing in the database, and responding to queries made from any other agent (column 8, lines 14-16, 29-34, where data is stored in a machine database listed in column 6, lines 52-55); wherein, each agent determines whether or not its current performance is consistent with its past performance based upon a continuous, real-time analysis of the agent's own database (column 12, lines 57-67, where the system is monitored by an agent) and, in the event that an agent determines that its current performance is inconsistent with its past performance, addresses the inconsistency (column 12, lines 57-67, where the system is monitored by an agent).

29. As for claim 30, Willard disclosed all of the limitations described in claim 29, including wherein addressing the inconsistency comprises querying a second agent (column 8, lines 29-34, where the different agent is a second agent).

30. As for claim 31, Willard disclosed all of the limitations described in claim 29, including wherein addressing the inconsistency comprises querying a human user (column 7, lines 34-37).

31. As for claim 32, Willard disclosed all of the limitations described in claim 29, including wherein addressing the inconsistency comprises querying a server (column 7, lines 19-22, where the providers are independent entities containing their own servers/databases and obtaining the information requires that the appropriate servers be notified).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willard, as applied to claim 10 above, in view of Benveniste (Pre-Grant Publication No. US 2002/0154653 A1).

34. As for claim 11, Willard disclosed all of the limitations described in claim 10. However, Willard doesn't explicitly state wherein the notification is postponed while the first agent is not able to communicate with the second agent. On the other hand, Benveniste did teach wherein the notification is postponed while the first agent is not able to communicate with the second agent (0021, lines 24-33, where the transmission is between two agents and the greater spacing is a form of postponing a transmission).

Both the systems of Willard and Benveniste are directed towards methods/systems of providing better functionality to peer-to-peer networks and therefore, it would have been obvious to a person of ordinary skill, in the art at the time of the invention, to combine the teachings of Willard, to utilize transmission postponing, as taught by Benveniste, in order to best utilize system resources and increase the overall speed and efficiency.

35. As for claim 12, Willard disclosed all of the limitations described in claim 10. However, Willard doesn't explicitly state wherein the notification is postponed until a period of low latency and low utilization of a communications network connecting the first agent and the second agent. On the other hand, Benveniste did teach wherein the notification is postponed until a period of low latency and low utilization of a

communications network connecting the first agent and the second agent (0021, lines 19-19).

Both the systems of Willard and Benveniste are directed towards methods/systems of providing better functionality to peer-to-peer networks and therefore, it would have been obvious to a person of ordinary skill, in the art at the time of the invention, to combine the teachings of Willard, to utilize transmission postponing, as taught by Benveniste, in order to best utilize system resources and increase the overall speed and efficiency.

36. Claim 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willard, as applied to claim 1 above, in view of Howard et al. (Pre-Grant Publication No. US 2004/0193653 A1), hereinafter Howard.

37. As for claim 21, Willard disclosed all of the limitations described in claim 1. However, Willard didn't explicitly state wherein the database is selectively pruned to reduce its size. On the other hand, Howard did teach wherein the database is selectively pruned to reduce its size (0010, lines 17-22). Both the systems of Willard and Howard are directed towards methods/systems of providing better functionality to distributed computing systems and therefore, it would have been obvious to a person of ordinary skill, in the art at the time of the invention, to combine the teachings of Willard, to utilize database pruning, as taught by Howard, in order to reduce the overhead of

maintaining larger databases and also, reduce the search time as the database contains less data.

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- (a) Duimovich et al. (Pre-Grant Publication No. US 2002/0052947 A1), a system for monitoring a networks performance.
- (b) Jenkins (Patent No. US 6,111,582), a system for reducing database sizes and also for controlling transmission with respect to low latency and utilization.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH L. GREENE whose telephone number is (571)270-3730. The examiner can normally be reached on Monday - Thursday from 9:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLG

/J. Bret Dennison/
Examiner, Art Unit 2143